

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appl. No.: 09/840,826
Attorney Docket No.: Q64154

REMARKS

General Matters

Claims 1-10 are all the claims pending in the application. Claims 1, 4, 5, 7, 8, and 10 stand finally rejected under 35 U.S.C. § 102(a) as being anticipated by Valtanen (WO 99/56231, hereinafter “Valtanen”). Claims 2, 3, 6, and 9 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Valtanen.

Prior Art Rejections

A. Rejections under § 102. Claims 1, 4, 5, 7, 8, and 10 stand finally rejected under 35 U.S.C. § 102(a) as being anticipated by Valtanen.

Independent Claim 1

Applicant respectfully traverses this rejection, first with respect to independent claim 1, in view of its requirements for:

said commerce provider server stores said selected service in correspondence with said purchaser identification number, wherein said selected service along with said purchaser identification number is written into said data holder; a data reader (5) for reading said selected service and said purchaser identification number from said data holder; a data collating terminal (4), connected between said data reader and said network, for receiving said selected service along with said purchaser identification number in advance, and collating said selected service and said purchaser identification from said data reader with those of said commerce provider server to verify whether or not a purchaser having said data holder is a true one.

Claim 1 requires that both the selected service and the purchaser identification number be written into the data holder so that the data collating terminal receives both the selected service along with the purchaser identification number. By contrast, the Valtanen “physical substitute”

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has only an identifier of the purchaser (*see* pg. 5, ln. 2-5, Valtanen) and lacks the requirement that the data holder include the selected service.

In the response dated February 4, 2004, Applicant pointed out that Valtanen lacks the requirement for the data collating terminal to receive a selected service along with the purchaser identification number in advance. The Examiner disagreed, arguing that Valtanen teaches that device B receives identifier 1 for a trade (*see* pg. 5, ln. 15-25, Valtanen). However, Valtanen's teaching of a device that receives only the identifier / purchaser identification number does not meet the requirement of the claims for a data collating terminal that receives both the specific service to be redeemed and the purchaser identification number.

When a customer arrives and provides the "physical substitute" to a reader using the approach described by Valtanen, only an identification of the purchaser is provided on the physical substitute, and it is unclear what the selected service is. In the event that the purchaser had selected multiple services, more processing would be required in the Valtanen system because the selected service is not indicated from the data holder to the data collating terminal.

Valtanen is therefore deficient with respect to the above identified requirements of independent claim 1. Valtanen cannot reasonably be said to anticipate claim 1 within the meaning of 35 U.S.C. §102. Furthermore, Valtanen lacks any suggestion that would have motivated or enabled the artisan of ordinary skill to have augmented the Valtanen approach to include such a selected service. Additional, untaught modifications would have been necessary. Applicant therefore respectfully submits that the person of ordinary skill would not have (and could not have) been equipped by Valtanen to achieve the subject matter of independent claim 1.

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Thus, Valtanen also cannot reasonably be said to render claim 1 of unpatentable within even the meaning of 35 U.S.C. § 103.

Applicant therefore respectfully requests the Examiner to withdraw this rejection of independent claim 1, and also its dependent claims.

The foregoing comments apply with equal force to the rejection of independent claims 5, 8, and 10 in view of their respective requirements relating to "a selected service and a purchaser identification number", as shown below:

- Independent Claim 5: "said selected service along with said purchaser identification number is written into said data holder"
- Independent Claim 8: "writing said selected service along with said purchaser identification number in said data holder; reading said selected service along with said purchaser identification number from said data holder"
- Independent Claim 10: "writing said selected service along with said purchaser identification number in said data holder; reading said selected service along with said purchaser identification number from said data holder by said data reader"

The above facts clearly distinguish the claimed invention from the prior art which means Valtanen does not teach each and every feature of the claimed invention. In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw the above 35 U.S.C. § 102(a) rejection of all of independent claims 1, 5, 8, and 10, as well as their respective dependent claims.

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B. Rejections under § 103. Dependent claims 2, 3, 6, and 9 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Valtanen. Applicant has already pointed out, above, that Valtanen does not render any of the independent claims unpatentable within the meaning of 35 U.S.C. § 103. Of course, this same reasoning applies also to the dependent claims 2, 3, 6, and 9. Applicant thus respectfully requests the Examiner to withdraw this rejection of claims 2, 3, 6, and 9.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

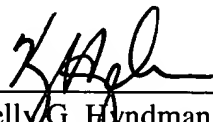
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